In response to the Office Action dated July 20, 2006, Applicants respectfully request reconsideration based on the above claim amendment and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 8-9 are rejected under 35 USC §102(e) as being anticipated by McDowell (US Pat. App. 20020035605). Claims 1-2 and 4-13 are rejected under §103(a) as being unpatentable over McDowell in view of Doss (US 20020188620). Claims 1 and 7-10 have been amended to correct antecedent basis. No new matter has been added.

Interview Summary

A telephonic interview between Applicants' representative, Arno Naeckel (#56,114), and the Examiner was held on October 16 to discuss the Examiner's rejections. During the interview several typographical errors concerning the Examiner's citations were corrected. The reasoning behind the Examiner's rejections was then further discussed.

Claim Objections

Claim 8 has been amended to correct a typographical error as requested. The objection to claim 8 can now be withdrawn.

102 Rejections

In the Office Action, claims 8 and 9 are rejected under 35 U.S.C. §102(e) as being anticipated by McDowell. To anticipate, a reference must describe each and every element of the claims. MPEP 2131. Applicants respectfully assert that McDowell fails to describe all of the claim elements.

Amended independent claim 8 recites in pertinent part:

"[a] method of receiving data sent from a first computing device to at least one of a plurality of second computing devices over a wireless digital packet-switched network… comprising…receiving data from **a messaging application running on the first computing device** over a wireless digital packet-switched network, while maintaining contact with a remote system accessing application running on the computing device via the wireless digital packet-switched network… forwarding the data from the messaging application to a messaging server via the protocol server…".

McDowell fails to describe a "messaging application running on the first computing device". On page 3, the Office Action expressly equates the wireless subscriber (**210), WAP** Gateway **136** and **IM Server** of McDowell (Fig. 2) to the first computing device, protocol server and instant messaging server, respectively, recited in the claim 8. Applicants contend that McDowell teaches that only a WAP browser is running on the first computing device.

In support of this distinction, McDowell describes that instant messaging capability is provided through a WAP client or a two-way SMS web page (Para. 0092, 0097). McDowell is explicit in explaining that "WAP" generically refers to any wireless internet protocol such as HTML. (Para. 0093). McDowell also describes that the **IM server** is independent of the client platform used by the wireless subscriber **210.** (Para. 0095).

In McDowell, a wireless subscriber **210** (the first computing device) accesses a WAP web page on a server which allows the wireless subscriber to read and compose IM messages and to manage buddy lists. (Para. 0092). In other words, McDowell describes the use of only a WAP browser application (a first application) at the wireless subscriber **210** (the first computing device) and not a messaging application. The messaging application in McDowell is located elsewhere.

Relatedly, the WAP browser can not be both a messaging application and a remote system accessing application. To the contrary, a WAP browser has a single function which is to allow remote access to a remote computer's web page interface. In McDowell, the WAP browser used by the wireless subscriber **210** merely communicates with a WAP Gateway **136** (Protocol Server) web page to request data. It is not a messaging application. (Para. 0083; Fig. 2, Items 201 and 207).

Further, McDowell recites that "[i]n the future, WAP and SMS may give way to new wireless operating systems...or embedded IM and buddy lists in client wireless devices themselves". (Para. 0095). As such, McDowell is implicitly conceding that wireless instant messaging and IM buddy list applications did not exist in client wireless devices at the time of McDowell's filing and therefore are not being described by McDowell to be running on the first computing device (the wireless subscriber **210).** For prior art to anticipate within the context of §102, the prior art must contain enabling disclosure of the asserted subject matter. The mere naming or description of the subject matter is insufficient if it can not be produced without undue

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experimentation. MPEP 2121.01. Since McDowell has expressly established that the technology for wireless IM capability or for embedded IM/buddy lists in wireless devices did not exist in the art at the time of its filing, its disclosure is not enabling in this respect. Therefore, McDowell is not §102 prior art for the proposition that McDowell describes receiving data from a messaging application running on the first computing device over a wireless digital packet-switched network.

As such, McDowell fails to describe a messaging application running on the first computing device for the above reasons. Since McDowell fails to describe all of the claim elements, independent claim 8 is allowable over McDowell. Dependent claim 9 depends from an allowable independent claim 8 and is allowable for at least the same reasons.

103 Rejections

Claims 1-2 and 4-13 stand rejected as being unpatentable under McDowell in view of Doss. Although independent claim 10 and its dependents 11-13 have not been specifically addressed in the Office Action, Applicants assume that they have been rejected on the same grounds.

In its rejection, the Office Action asserts that McDowell teaches or suggests most of the claim elements. However, the Office Action concedes that McDowell fails to describe a wireless modem at the client device and proceeds by asserting that Doss cures the deficiency of McDowell.

In regard to dependent claim 5, the Office Action further concedes that the combination of McDowell and Doss fails to describe "that the user identifier comprises one of a group of allowed recipients the method further comprising detecting at the instant messaging server whether the user identifier is of the group of allowed recipients and delivering the message only when the user identifier is of the allowed group". The Office Action proceeds further by asserting Official Notice that a "user identifier comprises one of a group of allowed recipients the method further comprising detecting at the instant messaging server whether the user identifier is of the group of allowed recipients and delivering the message only when the user identifier is of the allowed group", is old in the art.

It is respectfully submitted that neither McDowell nor Doss, alone or in combination, teaches, describes, or suggests each of the elements specified in independent claims 1, 7 and 10.

Independent claims 1 and 7 recite similar elements. As a representative example, independent claim 1 recites in pertinent part:

>"[[a] method of sending data from a first computing device to at least one of a plurality of second computing devices over a wireless digital packet-switched network, the method comprising:
>   initiating a first application on a first computing device…first application for accessing and retrieving legacy data…
>   initiating a second application on the first computing device, the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device to an instant messaging server via the protocol server over a wireless digital packet-switched network;
>   generating data to be sent from the first computing device to the at least one of the plurality of second computing devices, wherein data is generatable …from the second application as an instant message…"

McDowell fails to describe that the second application provid[es] an instant messaging service and enable[es] instant messaging data to be sent from the first computing device to an instant messaging server …wherein data is generatable …from the second application as an instant message…"

On page 4, the Office Action expressly equates the wireless subscriber (**210**), WAP Gateway **136** and **IM Server** of McDowell (Fig. 2) to the first computing device, protocol server and instant messaging server, respectively, recited in the claim 1. For the reasons discussed above in regards to the §102 rejections, McDowell is not describing initiating a second application on the first computing device, the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device…wherein data is generatable …from the second application **as an instant message**…". McDowell merely describes the use of a single WAP browser application at the wireless subscriber **210** (the first computing device), not an instant messaging application.

As discussed above in regard to the §102 rejections, the WAP browser can not be both a messaging application and a remote system accessing application. In McDowell, the WAP browser of the wireless subscriber **210** merely communicates with a WAP Gateway **136** to request data. It is not a messaging application.

Therefore, since McDowell fails to describe initiating a second application on the first computing device, providing an instant messaging service…wherein data is generatable from the

second application **as an instant message**, McDowell fails to describe the subject matter for which McDowell was asserted. Doss is directed to a dynamically enhanced database search comprising a static database and a dynamic database. As Doss does not address the use of an IM application on a wireless device, Doss fails to cure this particular deficiency of McDowell.

In regards to claims 10-13, amended independent claim 10 recites, in pertinent part:

"[a] system for sending data over a wireless digital packet-switched network from a first computing device to at least one of a plurality of second computing devices…comprising…:
the first computing device implementing …an instant message application that generates instant messages…and wherein the protocol server …receives the instant messages and forwards them to the instant messaging server for delivery…".

For the reasons discussed above in regards to independent claims 1, 7 and 8, McDowell is not describing the first computing device implementing …**an instant message application that generates instant messages**…and wherein **the protocol server …receives the instant messages** and forwards them to the instant messaging server for delivery. As discussed above, McDowell teaches the use of a single WAP browser application at the wireless subscriber **210** (the first computing device) and not an instant message application that generates instant messages. Therefore, McDowell fails to describe the subject matter for which McDowell was asserted. As Doss does not discuss the use of an IM application on a wireless device, Doss fails to cure this particular deficiency of McDowell.

For the above reasons, Applicants respectfully assert that the combination of McDowell and Doss fails to describe all of the claim elements of independent claims 1, 7, and 10 and independent claims 1, 7 and 10 are allowable over the combination of McDowell and Doss. Dependent claims 2, 4-6, 9, and 11-13 depend from an allowable independent claim 1, 7 or 10 and are allowable for at least the same reasons.

As for dependent claim 5, Applicants note that official notice of facts unsupported by documentary evidence "must be capable of such instant and unquestionable demonstration as to defy dispute" or is otherwise improper. MPEP 2144.03. Applicants respectfully submit that the recitations of claim 5 are not capable of such instant and unquestionable demonstration as to defy dispute. Therefore, the Examiner's official notice does not meet the standard of MPEP 2144.03 and is therefore improper in regards to claim 5. Therefore, Applicants respectfully request that an authority for the official notice be produced or the claim allowed.

Conclusion

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants' attorney at the number listed below.

At this time, no fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025

Respectfully submitted,

Date: October 20, 2006

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